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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,433	06/30/2003	Peter J. Kight	23952-0060	7158
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SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER LOFTUS, ANN E	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 11/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,433

Applicant(s)

KIGHT ET AL.

Examiner

Ann Loftus

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/19/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15, 17-37 and 39-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-37 and 39-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/13/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to an amendment filed on 9/19/07. Claims 13-15, 17-37, and 39-52 are pending. Claims 13, 19, 21, 32, 37, and 40 are amended. Claims 16 and 38 are cancelled. Claims 51 and 52 are added.

In the remarks filed 2/2/06, the applicant disclaims priority from US Patent application 09/2500711. The applicant claims priority from a continuation in part of application 09/795314, which is a division of 09/034561, filed 3/3/98. The latter has become US Patent No. 6289322.

Response to Arguments

2. Applicant's arguments with respect to claims 13-15, 17-37, and 39-52 have been considered but are moot in view of the new ground(s) of rejection: US Patent 6285991 filed Dec 13 1996 by Powar.

The drawings are accepted.

The applicant made reference to a Board decision in a related case that addresses what Hogan teaches about email protocols in bill payment systems. It was the Appeal Decision of 7/28/2005 in the prosecution of US Patent 7120602, which used to be US Application 09/867587, published as 20020046166. The examiner notes that the Board decision predates KSR Int'l Co. v. Teleflex, Inc., No. 04-1350 (U.S. Apr. 30, 2007). In light of KSR, the precedential value of the Appeal decision is indeterminate. A second factor that lessens applicability to the instant case is that part of the decision

discusses what Hogan anticipates, instead of what Hogan teaches. However, the examiner thanks the applicant for bringing this information into the prosecution.

Claim Rejections - 35 USC § 112

3. Claims 13, 32, 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 13, 32, 51 and 52, the claims recite transmitting a notice containing a hyperlink via an email protocol, then receiving a request by a protocol other than the email protocol, wherein the request is associated with the activation of the hyperlink (omitting certain phrases for emphasis). The words protocol and hyperlink do not appear in the specification filed 6/30/03. The examiner finds paragraph 72 to be enabling for this section of the claim, because a person of ordinary skill in the art at the time of the invention would know how to set up an email notice containing a hyperlink such that clicking on the hyperlink generates an HTTP request (HTTP refers to hypertext transfer protocol). The problem is not the central idea of the claim, but rather the metes and bounds.

If the art is Internet billing systems, then a person of ordinary skill in the art would understand protocol to mean one of the many sets of formal rules that define communications between systems. There are at least two SMTP (Simple Mail Transfer Protocol, 1982) and POP (Post Office Protocol, 1984) that are directly associated with email, but to actually send an email requires a stack of protocols, not just these two. If

for example, sending the email uses POP and SMTP, and also HTTP and TCP/IP over Ethernet over twisted pair, then when the claim refers to a protocol other than the email protocol, which ones are excluded from the request?

On the other hand, the broadest reasonable interpretation of protocol would be any set of rules for communication, which would not require a formally defined protocol. Under this scenario, it becomes even harder to decide which rule sets were used in the first transmission, thus excluded from the request. Is HTML an email protocol? The metes and bounds of the claims are unclear, thus the claims are rejected.

The examiner will presume in light of the specification that the ordinary HTTP request generated by a browser clicking on a link is not excluded by the phrase "other than email."

Further as to claims 13 and 32, does the phrase "via a network" modify the transmitting or supporting?

As to claims 51 and 52, the claims are unclear because there are two antecedent subscribers. Is the notice sent to the first or second subscriber?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5699528 filed 31 Oct 1995 by Hogan, and further in view of US Patent 6285991 filed Dec 13 1996 by Powar 5920847, and further in view of US Patent filed Oct 7, 1996 by Kolling et al.

As to claims 13 and 32, Hogan teaches in col 6 lines 20-30 and col 2 near line 38 transmitting, to a subscriber by an electronic bill presentment and payment service provider supporting multiple billers and multiple subscribers via a network, a notice of availability of bill presentment information representing a bill via an email protocol.

The next limitation is that the notice includes a hyperlink that facilitates access to the bill presentment information on the network. Hogan teaches the bill presentment information is accessible via browser on the network, col 2 lines 30-35. Hogan does not explicitly teach an emailed notice containing a hyperlink that facilitates access to the information. Powar in col 5 lines 17-38 teaches that emailing a notice containing a hyperlink that facilitates access to information such as bill information was a known technique at the time of the invention. Powar also teaches the subscriber activating the link. Clicking on a hyperlink implicitly generates an HTTP request for the page listed in the url in the hyperlink, which in this case is interpreted as a request for the bill presentment information. This request in context constitutes receiving by the electronic bill presentment and payment service provider via a protocol other than the email protocol, a request from the subscriber for the bill presentment information, wherein the received request is associated with an activation of the hyperlink by the subscriber.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan with predictable results and a reasonable expectation of success to add emailing a notice containing a hyperlink that facilitates access to the bill presentment information on the network, and receiving by the electronic bill presentment and payment service provider via a protocol other than the email protocol, a request from the subscriber for the bill presentment information, wherein the received request is associated with an activation of the hyperlink by the subscriber. The motivation would be to provide convenient access for the customer so that the customer does not have to remember or type a URL. Another benefit is to enable parameters to be encoded in the hyperlink and delivered back to the server without making the customer type the parameters.

Hogan teaches the bill presentment information is accessible via browser on the network, col 2 lines 30-35. This would be interpreted by one of ordinary skill in the art to mean that the web server, in response to an HTTP request, will deliver to the requester the bill presentment information. Thus Hogan teaches transmitting to the subscriber by the electronic bill presentment and payment service provider the bill presentment information representing the bill from a biller for the subscriber responsive to the request.

Hogan teaches in col 6 lines 30-64 receiving a payment instruction for the bill from the subscriber for payment.

Hogan does not specifically teach generating the remittance advice. Kolling teaches generating remittance advice (payment message) based on the received

payment instruction (bill pay order) in col 29 line 37-65. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include generating the remittance advice because if the billing service generates the remittance advice, they can put their logo and advertising with it.

Hogan teaches in claim 18 transmitting the remittance advice to the biller.

As to claims 14 and 33, Hogan teaches generating the bill presentment information based on original bill information representing the bill in Figure 4, and described in col 6.

As to claims 15 and 34, Hogan teaches the generated bill presentment information including a summary of the bill represented by the original bill information in Figure 4, and described in col 6.

As to claims 16 and 38, see above regarding generating remittance advice.

As to claims 17 and 35, Hogan teaches in col 4 lines 53-60, the original bill information received from the biller.

As to claims 20 and 39 Hogan teaches in col 6 lines 30-65 transmitting a presentation of a payment request screen, wherein the payment request screen includes at least a portion of the information associated with the bill from the biller.

As to claims 21 and 40, Hogan teaches a payment request summary with the name of the biller, an amount of the bill and a due date for payment of the bill in col 10, lines 52-59. Hogan teaches information with the payment request including name of the biller and amount of the bill in Figure 4. Hogan teaches including the due date with payment request information as a screen default in col 11 lines 37-48.

As to claims 22 and 41, Hogan teaches transmitting a payment associated with the payment instruction in col 8 lines 39 to 62.

As to claims 23, 24, 42 and 43, Hogan teaches an electronic payment in col 8 lines 39 to 62, including remittance advice. Hogan does not specifically teach a check payment by a billing service. Kolling teaches a payment by check in col 7 line 52 to col 8 line 4, including remittance advice. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include a billing service making a payment by check because some merchants prefer to be paid by check, and that would allow the service to accommodate more merchants.

As to claims 25 and 44, Hogan teaches a remittance advice transmitted to the biller via financial institution associated with the biller in col 8 lines 24-63, and figure 5.

As to claims 26 and 45, Hogan does not specifically teach a consolidated remittance advice. Kolling teaches in col 7 line 52 to col 8 line 4 a consolidated remittance advice based on payment instructions from more than one subscriber. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include a consolidated remittance advice because it simplifies the processing for the recipient of the advice.

As to claims 28, 47, 51 and 52 Hogan teaches multiple subscribers who each see their own bills in col 5 lines 2-4, and protection against unauthorized access in col 5 lines 45-53. In Figure 4, and described in col 6, Hogan teaches transmitting to a subscriber electronic bill presentment information representing a bill. Thus for the

second of the multiple subscribers, Hogan teaches transmitting to a second subscriber electronic bill presentment information representing a second bill.

As above under claims 13 and 32, the Hogan Powar combination teaches transmitting to the subscriber by the electronic bill presentment and payment service provider via the network a notice of availability of bill presentment information representing a bill via the email protocol, wherein the notice includes a hyperlink that facilitates access to the bill presentment information on the network. As Hogan teaches multiple subscribers, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to combine these teachings to get transmitting a second notice of a second bill with a second hyperlink to a subscriber in order to allow multiple customers to use the service.

As to claims 29-31 and 48-50, Hogan does not specifically teach transmitting a consolidated payment by check with a consolidated remittance advice. Kolling teaches transmitting a consolidated payment by check with a remittance advice in col 7 line 52 to col 8 line 4. It would have been obvious to a person of ordinary skill in the art to modify Hogan to include consolidated payment by check with a consolidated remittance advice because consolidation simplifies processing and because merchants accept checks and because transmitting them together helps the recipient crosscheck the payments claimed in the advice against the sum received.

6. Claims 18 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of US Patent No 5220501 filed 8 Dec 1989 by Lawlor et al.

Hogan teaches bill presentment information generated for presentation from the original bill information in Figure 4. Hogan does not teach generating the presentment information from a template. Lawlor teaches a template for generating a presentation of bill information in col 37 line 65 to col 38 line 65. It was old and well-known at the time of the invention to generate a presentation screen from a template as Lawlor teaches. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include generating bill presentment information from the original bill information with a template because templates enable efficient storage of a particular reusable format, as opposed to storing an individualized format for each bill. Templates allow quick assembly of pieces of data into a coherent design, and re-use of the design allows users to gain familiarity with it.

7. Claims 19 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of an article by Wu from the Association for Computing Machinery dated 1992 and titled "The Practical Need for Fourth Normal Form."

Hogan teaches original bill information in col 4 lines 53-60. Hogan does not specifically teach normalized information. Wu teaches normalizing information in the left column of page 19, in the Introduction. Wu is addressing efficient database techniques

used on any large collection of data to reduce size and improve update efficiency and accuracy. A person of ordinary skill in the art of billing systems would find it obvious to use a reference on efficient database techniques to help set up the databases involved in the billing system in order to take advantage of the latest techniques for reducing the storage requirements and increasing update efficiency and accuracy. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include normalizing original bill information in order to reduce storage requirements and increase update efficiency for the data in the billing system.

8. Claims 27 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of Official Notice.

As to claims 27 and 46, Hogan does not specifically teach a consolidated remittance advice. Kolling teaches in col 7 line 52 to col 8 line 4 a consolidated remittance advice based on payment instructions from more than one subscriber. Kolling teaches a check and list, but does not specifically say the list is printed. Official Notice is taken that printing business correspondence is old and well-known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include a consolidated remittance advice that was printed, because a printed list takes no special equipment, and can be read by any biller.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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AL
11/15/07



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